

Remarks

Claims 1-19 are pending in this application. Claims 1-18 have been amended. Amendments to the specification and abstract have also been made.

The abstract has been amended and it now contains greater than fifty words. Applicants respectfully request the objection to the abstract be withdrawn.

Claims 1-19 stand rejected under 35 U.S.C. 102(e) as anticipated by Published Patent Application U.S. 2002/0090934 to Mitchelmore filed on November 20, 2001. The rejection of these claims is not proper. The specification has been amended to claim priority to provisional application 60/273,558 filed March 7, 2001. Mitchelmore, filed November 20, 2001, was filed after the priority filing date of March 7, 2001 of the present invention.

Mitchelmore, however, claims priority to two provisional applications. One of the provisional applications was filed before the priority date of March 7, 2001 of the present application and one was filed after the priority date. In order for the rejection of claims 1-19 to be proper, the subject matter the Examiner is relying on to reject the claims must be supported by the provisional application with a filing date prior to March 7, 2001. The Examiner has not provided evidence that this is indeed the case. Accordingly, Applicants respectfully request the rejection of claims 1-19 be withdrawn.

In the alternative, if it can be demonstrated that Mitchelmore is prior art under § 102(e), Applicants submit that Mitchelmore fails to teach or to even suggest the limitations of independent claims 1 and 19, as amended. Independent claim 1 recites, *inter alia*, a “build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts.” The Office Action relies on paragraphs 8, 18 and 65 of Mitchelmore for teaching the above limitations. The above referenced paragraphs fail to disclose a “built-to-order configuration engine” which prevents conflicts and communicates with developers as set

forth in claim 1. Instead, Mitchelmore discloses providing applications to handheld devices in a more efficient and effective manner. The specific paragraphs cited by the Examiner do not go so far as to mention these limitations. Thus, Mitchelmore fails to teach all of the limitations of independent claim 1 and does not thereby anticipate claim 1. Moreover, the incorporation of a built to order engine which prevents conflicts and communicates with developers as set forth in the claims would not be obvious because under Mitchelmore content monitoring would become more difficult and thereby hindering efficient content monitoring. Furthermore dependant claims 2-18 depend from independent claim 1 and recite further limitations not found in Mitchelmore, or other prior art cited but not relied upon by the Examiner. Applicant respectfully requests that the rejection of claims 1-18 be traversed.

Independent claim 19, *inter alia*, recites “querying the handheld device to ensure sufficient memory is available and reporting an error back to the user if necessary.” Paragraphs 100 and 182 of Mitchelmore are relied upon to anticipate the action of querying to determine whether sufficient memory is available to accommodate the software. However, at no point either in paragraphs 100 and 182 or elsewhere in the entire Mitchelmore publication is the amount of available memory measured or tested. Furthermore, Mitchelmore does not discuss reporting to the user the need for additional memory, such as a memory card, if sufficient memory is not available, as recited in claim 19. As a result, Mitchelmore fails to disclose all the limitations of independent claim 19. Thereby, Applicants respectfully request the rejection of claim 19 be withdrawn.

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In view of the above amendment, applicant believes the pending application is in condition for allowance.

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